

## **REMARKS**

Claims 1-42 were presented in the application as filed on February 17, 2004 and claims 1-23 were canceled in a Preliminary Amendment concurrently filed. Group I (claims 24-34 and 42) were elected in a Response filed December 6, 2006. Claims 27 and 28 were amended and claims 35-41 were canceled in a Response filed December 17, 2007. Claims 33, 34, and 42 are canceled. Claims 24-32 are pending. Reconsideration of the application and allowance of all claims pending herein are respectfully requested in view of the remarks below.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

The Office Action states that claims 33, 34, and 42 are rejected under 35 U.S.C. §112, first paragraph, because the specification does not provide enablement for non-carbon based particles. Without acceding to the propriety of the rejection, claims 33, 34, and 42 have been canceled to expedite prosecution.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

The Office Action states that claims 24-34 are rejected under 35 U.S.C. §102(a) as being anticipated by C.W. ("Heat spurs growth of tiny carbon trees"). Claim 24 is independent.

Applicants respectfully assert that the disclosure by C.W. was derived from Applicants' own work and that the disclosure made within the year before effective filing date of the present application (March 16, 2001) can not be used against the inventors under 35 U.S.C. §102(a); see *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Applicants (Richard S. Siegel, John M. Nugent, and Pulickel M. Ajayan) have provided declarations in accordance with MPEP 2132.01 stating that the co-authors of C.W. (B. Wei and Ph. Kohler-Redlich) were working under the direction of Siegel, Nugent, and Ajayan and were not inventors of the subject matter of the present application. See Exhibit A. The disclosure C.W. was a research paper.

In *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982), Katz stated in a declaration that the coauthors of the publication, Chiorazzi and Eshhar, "were students working under the direction and supervision of the inventor, Dr. David H. Katz." The court held that the publication was a research paper, was enough to establish Katz as the sole inventor and that the work

described in the publication was his own. In research papers, students involved only with assay and testing are normally listed as coauthors but are not considered co-inventors.

In light of the above, Applicants respectfully assert that C.W. is not an anticipating reference. C.W. was a disclosure of the Applicants own work and/or invention. Reconsideration of claim 1 under 35 U.S.C. § 102(a) is respectfully requested.

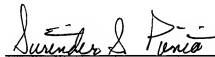
#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

The Office Action states that claims 33, 34, and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ajayan article as applied to claims 24-34. Claims 33, 34, and 42 have been canceled to expedite prosecution and thus, the present rejection is moot.

There being no other outstanding issues, it is believed that the application is in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned agent invites the Examiner to telephone him at the number provided.

***Respectfully submitted,***

A handwritten signature in dark ink, appearing to read 'Surinder S. Punia', is written over a horizontal line.

Surinder S. Punia  
Agent for Applicants  
Registration No. 60,045

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#### **HESLIN ROTHENBERG FARLEY & MESITI, P.C.**

5 Columbia Circle  
Albany, New York 12203  
Telephone: (518) 452-5600  
Facsimile: (518) 452-5579